

REMARKS

In the February 25, 2009 Office Action, all of the claims 1-4 and 6-10 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the February 25, 2009 Office Action, Applicant has amended claim 1 as indicated above. Thus, claims 1-4 and 6-10 are pending, with claim 1 being the only independent claim. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Rejections - 35 U.S.C. § 102

In paragraphs 2 and 3 of the Office Action, claims 1-4, 6 and 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,925,832 (Kitaura et al.). In response, Applicant respectfully traverses this rejection, especially in view of the amendments to independent claim 1, as explained below.

First, the Kitaura et al. patent does not disclose or suggest **(1)** a suction pipe fluidly connected to the low pressure space of the casing; and **(2)** the low pressure space communicating with a suction port of the compression mechanism, as required by previously presented independent claim 1. Specifically, the Kitaura et al. patent indicates that **(1)** the suction pipe (19) is fitted into the aperture (66) and that the aperture (66) communicates the compression chamber (40) with the suction pipe (19); and **(2)** the auxiliary suction passage (67) communicates the low pressure space (29) with the compression chamber (40). See column 7, lines 3-15 and column 9 lines 13-24 of the Kitaura et al. patent. Please note that Figure 2 is the only Figure in the Kitaura et al. patent illustrating the auxiliary aperture (67). Based on the above sections and Figure 2 of the Kitaura et al. patent, the Kitaura et al. patent does *not* disclose that the suction pipe (19) is fluidly connected to the low pressure space (29), as asserted in the Office Action. Rather, the Office Action appears to assume that the port (66) somehow communicates the suction pipe (19) with the low pressure space (29) even though the drawings and disclosure provide insufficient evidence that this is true. Therefore, the Kitamura et al. patent cannot disclose or suggest the structure of independent claim 1 as previously presented.

Additionally, even though Applicant disagrees with the Office Action, Applicant has amended independent claim 1 to even more clearly define the present invention over the prior art. In particular, independent claim 1 now requires, *inter alia*, the suction port having an inner end open to the cylinder chamber and an outer end open to the low pressure space; and the casing having a suction pipe fluidly connected to the low pressure space of the casing and a discharge pipe connected to a high pressure space side thereof, the suction pipe having an open end spaced from the outer end of the suction port and disposed in the low pressure space such that the open free end of the suction pipe opens into the low pressure space to directly supply fluid into the low pressure space and indirectly supply fluid to the outer end of the suction port via the low pressure space. Clearly, this structure is **not** disclosed or suggested by the Kitamura et al. patent or any other prior art of record.

Rather, in the Kitamura et al. patent, the suction pipe (19) has the free open end fitted into the suction aperture (66) of the fixed scroll (24) so that the free open end of the suction pipe (19) is **not** spaced from an outer end of a suction port (e.g., aperture (66) or (67)). Also, due to this arrangement, the suction pipe (19) of the Kitamura et al. patent does **not** have a free open end disposed in the low pressure space (29) such that the open free end of the suction pipe (19) opens into the low pressure space (29) to directly supply fluid into the low pressure space (29) and indirectly supply fluid to the outer end of the suction port (66) via the low pressure space (29). Therefore, the Kitamura et al. patent cannot disclose or suggest the structure of independent claim 1 as now amended.

It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. As explained above, the Kitamura et al. patent fails to disclose or suggest all of the limitations of previously presented independent claim 1, or all of the limitations of independent claim 1 as now amended. Accordingly, withdrawal of this rejection of independent claim 1 is respectfully requested.

Moreover, Applicant believes that dependent claims 2-4, 6 and 10 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 2-4, 6 and 10 are further allowable because they include additional limitations, which in combination with the features of independent claim 1, are not disclosed or suggested in the prior art. Accordingly, withdrawal of this rejection of dependent claims 2-4, 6 and 10 is also respectfully requested.

Rejections - 35 U.S.C. § 103

In paragraphs 5-7 of the Office Action, claims 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Kitaura et al. patent in view of U.S. Patent No. 3,125,031 (Rydberg et al.). In response, Applicant respectfully traverses this rejection, especially in view of the Amendments to independent claim 1.

Rydberg et al. do not account for the deficiencies of The Kitaura et al. patent as applied to independent claim 1, as previously presented or as now amended. The Office Action relies on the Rydberg et al. patent to teach features related to a blade, the manner in which the blade is coupled to a piston and the manner in which the piston is driven by the motor. However, the Rydberg et al. patent fails to disclose or suggest a suction pipe fluidly connected to such a low pressure space, and a discharge passage as set forth in independent claim 1. Rather, Rydberg et al. teach a suction pipe directly coupled to the suction port of the compression mechanism just like The Kitaura et al. patent. Based on the above, even if the Rydberg et al. patent were somehow combined with The Kitaura et al. patent as suggested in the Office Action, such a hypothetical combination would fail to disclose or suggest all of the features of independent claim 1. Accordingly, withdrawal of this rejection of claims 7-9, which depend from independent claim 1, is respectfully requested.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. In this case, the current record lacks any apparent reason, suggestion or expectation of success for further modifying the hypothetical device created by combining the Kitaura et al. patent and the Rydberg et al. patent to somehow create Applicants' unique arrangements of independent claim 1 as now amended. In fact, these references teach away from such a modification, because they specifically teach directly attaching the free open end of the suction pipe to the compression mechanism without a space therebetween.

* * *

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-4 and 6-10 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,

/Patrick A. Hilsmier/
Patrick A. Hilsmier
Reg. No. 46,034

GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444
Dated: June 24, 2009

S:\06-JUN09-YTY\DK-US065021 Amendment.doc